



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No.: 7601

Jaakko RAJANIEMI

Art Unit: 2617

Application No.: 10/500,370

Examiner: Jaime M. Holliday

Filed: July 28, 2004

Attorney Dkt. No.: 059864.01048

For: SERVICE ACCESS

**PETITION UNDER 37 C.F.R. § 1.181 REQUESTING REFUND OF REQUEST  
FOR CONTINUED EXAMINATION FEE DUE TO IMPROPER FINALITY**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

May 21, 2008

Sir:

This is a Petition requesting withdrawal of finality under 37 C.F.R. § 1.181. In a Response filed November 7, 2007, Applicant traversed a rejection in a non-final Office Action filed November 8, 2007. However, the final Office Action mailed February 21, 2008, did not consider the substance of the arguments made in Applicant's traversal, as required by MPEP § 707.07(f). In a Response to the final Office Action filed April 14, 2008, Applicant presented the following arguments:

On pages 15 and 16 of the Response filed November 8, 2007, Applicant traversed the rejection with respect to independent claims 1, 7, 21, 27 and 29-31, arguing, for example, that "Wright does not disclose or suggest the feature of a user specific record that determines if verification needs to take place". Further, the Applicant traversed the rejections of claims 15 and 35 on pages 17-19 of the Response filed November 8, 2007. However, despite Applicant's clear traversals, the outstanding Office Action failed to address Applicant's arguments. Rather,

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with respect to claim 1, the outstanding Office Action appears to have substantially copied the arguments presented on pages 4-6 of the Office Action mailed August 23, 2007. The arguments with respect to the other independent claims appear to have been similarly copied. Henry et al. is newly cited in the outstanding Office Action, but was only alleged to disclose that "the specific record is stored at a server node" (see page 4). With respect to claims 15 and 35, the Office Action also failed to respond to Applicant's arguments. The failure to respond to Applicant's traversals of the rejections presented in the Office Action mailed August 23, 2007, renders the finality of the outstanding Office Action improper.

MPEP § 707.07(f) states that "[i]n order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner **must** provide clear explanations of all actions taken by the examiner during prosecution of an application" (emphasis added). "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it" (*Id.*). "The examiner must address all arguments which have not already been responded to in the statement of the rejection" (MPEP § 707.07(f), Examiner Note 1).

The outstanding Office Action failed to address Applicant's clear traversals. In fact, it does not appear that any of Applicant's arguments are specifically addressed in the outstanding Office Action. Further, failure to specifically respond to Applicant's arguments renders the Office Action arbitrary and capricious, and therefore invalid under the Administrative Procedure Act (5 U.S.C. § 706), a standard to which all Actions by the USPTO must adhere (see *Dickenson v. Zurko*, 527 U.S. 150 (1999)). For at least these reasons, the finality of the outstanding Office Action is improper.

(Pages 17 and 18 of the Response filed April 14, 2008).

The subsequent Advisory Action mailed May 2, 2008, stated that "Examiner maintains that on pg. 2 of the Final Rejection, it is clearly stated that 'Applicant's arguments with respect to claims 1-21, 27 and 29-37 have been considered but are moot in view of the new ground(s) of rejection'" (see page 2). However, the new reference, Henry et al., was only introduced with respect to new recitations amended into the claims

in the Response filed November 8, 2007. Henry et al. was not intended to address Applicant's arguments that "Wright does not disclose or suggest the feature of a user specific record that determines if verification needs to take place". Further, the final Office Action did not address Applicant's arguments, for example, on page 17 that "[s]till further, the authentication vector of Wright is not 'user specific' when passed to the home operator network."

Applicant's representative telephoned the Examiner on May 8, 2008, and discussed the issue, but the Examiner did not withdraw the finality. Thus, after the consideration in the Advisory Action and the subsequent reconsideration in the telephone interview, the Examiner maintained the improper finality. For the reasons discussed above, Applicant respectfully submits that the finality is improper.

In order to prevent paying fees for an extension of time, Applicant timely filed this Petition with a Request for Continued Examination on May 21, 2008. Accordingly, because the finality is improper, Applicant respectfully requests that the \$810.00 fee associated with filing the Request for Continued Examination be refunded to Counsel's Deposit Account 50-2222.

In the event that any additional fees are required for this Petition, said fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Michael A. Leonard II  
Attorney for Applicant  
Registration No. 60,180

**Customer No. 32294**  
SQUIRE, SANDERS & DEMPSEY LLP  
14<sup>TH</sup> Floor  
8000 Towers Crescent Drive  
Tysons Corner, Virginia 22182-2700  
Telephone: 703-720-7800  
Fax: 703-720-7802

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